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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/067,171 | 02/04/2002 | Yoshiho Gotoh | MTS-710US27 | 6246 |

7590 10/06/2004
Ratner & Prestia
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Valley Forge, PA 19482

EXAMINER

CALLAHAN, PAUL E

ART UNIT PAPER NUMBER

2137

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,171

Applicant(s)

GOTOH ET AL.

Examiner

Paul Callahan

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36,37 and 39 is/are allowed.
- 6) ☒ Claim(s) 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/649,411.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09202004.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 09202004.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-35 were pending in this application and have been cancelled by preliminary amendment. New claims 36-39 have been added by preliminary amendment and have been examined.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/649,411, filed on 5-16-1996.

EXAMINER'S AMENDMENT

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Lawrence A. Ashery on 9-17-2004.

The application has been amended as follows:

Claims 38 and 39 have been amended to read as follows:

39. (Currently Amended) A method of reproducing an optical disk on which data is recorded, wherein in a prescribed region of said disk, an identifier is provided

for indicating whether a barcode-like mark is present or not on said optical disk, [said identifier and said barcode-like mark,] said barcode-like mark is disposed in a circumferential direction, said barcode-like mark has a plurality of bars, said method comprising the steps of:

- a) focusing a beam on an information layer of said optical disk,
- b) confirming said optical disk has a control data area and an identifier indicating the presence or not of said barcode-like mark, and
- c) controlling an optical head based on the step of said confirming b) whether or not to read a barcode-like mark.

Double Patenting

4. Claim 38 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,052,465. Although the conflicting claims are not identical, they are not patentably distinct from each other because They each claim identical subject matter, with an additional limitation in claim 1 of the Patent of the barcode-like mark and identifier being in separate locations on the disk. Claim 1 of the Patent is narrower than claim 38 of the instant application and therefore renders claim 38 obvious.

Allowable Subject Matter

5. Claims 36, 37, and 39 are allowed.

Art Unit: 2137

6. The following is an examiner's statement of reasons for allowance:

The prior art in the field does not teach the features found in the independent claims of an optical disk upon which there is present an identifier that indicates the presence or absence of a barcode-like mark on the disk. The closest prior art in the field, Lentz et al. US 5,430,281 only teaches a comparison between information stored in a data storage area of an optical disk (col. 6 lines 15-20), and the same information found on the disk encoded into barcode form. Lentz et al. does not teach the identifier and barcode-like mark of the applicant. The barcode of the applicant cannot be the same marking as the identifier. According to the claim language, the identifier must always be present on the disk. If the barcode and mark were the same marking, then the case where no barcode is present on the disk couldn't be indicated by an indicator marking, since it would also be absent. This feature of the claims is novel and unique and not found in the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336. The examiner can normally be reached on M-F from 9 to 5.

Art Unit: 2137

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Caldwell, can be reached on (703) 306-3036. The fax phone number for the organization where this application or proceeding is assigned is: (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

9/20/04

Paul Callahan